

REMARKS

I. STATUS OF THE CLAIMS

Claims 1-45 are pending. Claims 1-34 and 38-45 are withdrawn from consideration. Claims 35-37 are submitted for consideration herein.

II. REJECTION OF CLAIMS 36-37 UNDER 35 U.S.C. § 103

Page 2 of the Office Action rejects claims 36-37 under 35 U.S.C. § 112, first paragraph.

Page 2 of the Office Action further states, “In regards to claim 36, Examiner fails to interpret where in the specification including original claims is ‘wherein the sum of the secondary payouts multiplied by each secondary payout’s respective probability of occurring after the draw based on the held cards and discards is a predetermined number’ disclosed”

The Applicant respectfully wishes to point out Table V, paragraphs 74-75 and 69. Paragraph 75 shows that a sum of secondary payouts multiplied by each secondary payout’s respective probability of occurring equals 1 (a predetermined number). Furthermore, paragraph 69 states that, “The game return should preferably be set to .99 (99%) so that the player would consider the doubling bet a good bet and make it frequently. However, the casino (or game manufacturer) is free to choose whatever game return they wish.” The Applicant further submits that support for claim 36 is not limited to the sections of the specification cited and further support can be found in other places as well.

Page 2 of the Office Action further states, “In regards to claim 37, Examiner fails to interpret where in the specification including original claims is ‘wherein if the held cards comprise a winning rank on the first pay table, then a secondary award for the winning rank is automatically deactivated on the second pay table’ is disclosed.

The Applicant respectfully wishes to point out page 66 of the Application (in the Appendix), line 11, which states, “//player is dealt J or better and holds the pair, have to 0 out rank 9 payout.” The code sets the payout for the winning hand of jacks or better (a

rank 9 payout, for example see page 83, line 26, which states, "...ranks[9]="JACKS OR BETTER") to 0 (deactivated) on the dynamic payable when the player holds Jacks or better. Note paragraph 44 further states, "Note that certain payouts are not active in payable 2 300. For example, royal flush, straight flush, and flush all pay an amount of zero" which shows that a zero payout is considered to be "not active" or hence "deactivated."

Therefore, withdrawal of the rejections is respectfully requested.

III. REJECTION OF CLAIMS 35-37 UNDER DOUBLE PATENTING

Pages 2-3 of the Office Action reject claims 35-37 under nonstatutory double patenting over claims 1 and 3 of U.S. Patent No. 7,017,909.

The double patenting rejection is improper. MPEP 804 states, "Double patenting may exist between an issued patent and an application filed by the same inventive entity, or by a different inventive entity having a common inventor, and/or by a common assignee/owner."

There is no common inventor or common assignee of the 7,017,909 and the present application. Therefore, withdrawal of the double patenting rejection is respectfully requested.

IV. REJECTION OF CLAIMS 35-37 UNDER 35 U.S.C. § 103

Pages 4-9 of the Office Action reject claims 35-37 under 35 U.S.C. § 103(a) as being unpatentable over Awada (US 6,206,780) in view of Luciano (US 6,368,14) in further view of Jarvis (US 7,201,654).

Claim 35 recites, "wherein a first award from the first payable for a particular rank is higher than a second award from the first payable for a specific rank while a secondary award from the second payable for the particular rank is lower than a secondary award from the second payable for the specific rank;"

Page 6 of the Office Action states:

Awada in view of Luciano excludes the first award from the first pay table for a particular rank is higher than a second award from the first pay table for a specific rank while a secondary award from the second pay table for the particular rank is lower than a

secondary award from the second pay table for the specific rank. However, applicant has failed to disclose that such a limitation solves a particular problem or provides an advantage. One of ordinary skill in the art furthermore, would have expected the first and dynamic second payout tables of Awada in view of Luciano, and applicant's invention, to perform equally well with either the first and second payout tables (second table including adjusted payout based on probabilities) as taught by Awada in view of Luciano, or the claimed a first award from the first pay table for a particular rank is higher than a second award from the first pay table for a specific rank while a secondary award from the second pay table for the particular rank is lower than a secondary award from the second pay table for the specific rank because both provide the same function of providing a first and second payout table, and more specifically a second payout table with adjusted awards based on increasing or higher probabilities of achieving winning outcomes. Therefore, it would have been prima facie obvious to modify Awada in view of Luciano to obtain the invention with respect to claim 35 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Awada in view of Luciano.

Awada does not disclose a dynamic payable in which, "the secondary awards automatically updating based on the held cards and discards." The different paytables in Awada are all fixed, that is a different payable can be used for a different step of the game, but the awards do not change based on the held cards and discards.

Luciano also does not disclose a video poker game which changes secondary awards based on held cards and discards.

Further, the above passage states that, "However, applicant has failed to disclose that such a limitation solves a particular problem or provides an advantage." The Applicant states that one possible advantage of this structure is that a player may find such a second payable as claimed to be more exciting and may optionally (if the player's current situation allows, depending on the cards dealt and payout algorithms used) decide to play his hand in a non-standard fashion in order to capitalize on what might be larger payouts on the second payable. For example, see Table IV of the specification which shows that (in that particular example) a straight pays higher than a flush, while in the first payable in Figure 2 a flush pays higher than a straight (which is standard in video

poker). Using the payouts in Table IV, he player may decide to go for the straight in hopes of achieving the higher payout on the second payable.

The above passage also states, “Therefore, it would have been prima facie obvious to modify Awada in view of Luciano to obtain the invention with respect to claim 35 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Awada in view of Luciano.” The Applicant respectfully disagrees. Implementing the second payable as claimed in claim 35 allows for more exciting and varied game play, while maintaining the proper house advantage for particular situations, and is not a mere “design consideration.”

None of the applied references disclose a first payable and a second payable wherein a first award from the first payable for a particular rank is higher than a second award from the first payable for a specific rank while a secondary award from the second payable for the particular rank is lower than a secondary award from the second payable for the specific rank. In fact, in standard video poker, the payouts increase from bottom to top (such as the paytables used in Awada), which teaches award from a second payable as claimed in claim 35. Nothing in the combination of references suggests such a feature either.

Claim 36 recites, “wherein a sum of the secondary payouts multiplied by each secondary payout’s respective probability of occurring after the draw based on the held cards and discards is a predetermined number.”

Page 7 of the Office Action states, “Awada in view of Luciano in further view of Jarvis discloses the above with respect to claim 35, but excludes wherein the sum of the secondary payouts multiplied by each secondary payout’s respective probability of occurring after the draw based on the held cards and discards is a predetermined number. However, applicant has failed to disclose that such a limitation solves a particular problem or provides an advantage.

In response, the Applicant states that one possible advantage of claim 35 is that by using a predetermined number for the sum of the secondary payouts multiplied by each secondary payout’s respective probability of occurring after the draw based on the held cards and discards, the player will know what his theoretical return on the second wager

using the second payable will be, and thus this may encourage players to play the game. Otherwise, because the second payable will vary from case to case, it would be very difficult for the average player to compute the return based on the displayed payouts game instant game situation.

Page 7 of the Office Action further states, "One of ordinary skill in the art furthermore, would have expected the secondary payouts of Awada in view of Luciano in further view of Jarvis, and applicant's invention, to perform equally well with either the secondary payouts based on increased probabilities or probabilities of occurring as taught by Awada in view of Luciano in further view of Jarvis, or the claimed wherein the sum of the secondary payouts multiplied by each secondary payout's respective probability of occurring after the draw based on the held cards and discards is a predetermined number because both provide the same function of providing secondary adjusted awards based on increasing or higher probabilities of the player achieving various winning outcomes. Therefore, it would have been prima facie obvious to modify Awada in view of Luciano in further view of Jarvis to obtain the invention with respect to claim 36 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Awada in view of Luciano in further view of Jarvis."

In response, the Applicant states that the secondary payouts in Awada are not dynamic in that it does not change awards based on held cards and discards. Luciano also does not disclose a game that changes awards based on held cards and discards. While Luciano does disclose an updated payout table (See Figure 6C, 6D), Luciano is silent as to the theoretical return of an updated payout table. Jarvis discloses a single award for each particular outcome paid on a single wager, but not a payable with multiple ranks for a single second wager.

Therefore, the applicant submits that claim 36 is not taught or suggested by the applied references, individually or in combination.

Claim 37 recites, "wherein if the held cards comprise a winning rank on the first payable, then a secondary award for the winning rank is automatically deactivated on the second payable."

Page 8 of the Office Action states, “However, applicant has failed to disclose that such a limitation solves a particular problem or provides an advantage.”

In response, the Applicant submits that it is advantageous, when if the held cards comprises a winning rank on the first payable, then a secondary award for the winning rank is automatically deactivated from the payable, because if such payout is not deactivated, then the player would be guaranteed to at least achieve the winning on the second payable. If the player would be guaranteed to achieve the winning rank (and thus a guaranteed award), then the payouts on the remaining winning hands would typically have to be reduced, resulting in a less exciting game for the player.

Page 8 then goes on to say, “One of ordinary skill in the art furthermore, would have expected the payouts of the first and second pay tables of Awada in view of Luciano in further view of Jarvis, and applicant’s invention, to perform equally well with either available payouts indicated on the first and second payout tables of Awada in view of Luciano in further view of Jarvis, or the claimed wherein if the held cards comprise a winning rank on the first pay tale, then a secondary award for the winning rank is automatically deactivated on the second pay table because both provide the same function of providing payouts to a player based on a first and second wager of a final hand.

The above statement is incorrect because in Awada and Luciano it would not be possible to get into a situation as recited in claim 37 because in Awada there is no dynamic payable and in Luciano there is no dynamic payable based on held cards. Jarvis is silent about how it treats the situation when a player holds an already winning hand.

Therefore, the Applicant respectfully traverses the Examiner’s conclusion that claim 37 is prima facie obvious.

Thus, in view of all of the above, the Applicant submits that claims 35-37 are patentable over the applied references, and withdrawal of the rejections is respectfully requested.

IV. CONCLUSION

If there are any issues the Examiner wishes to discuss with the Applicant, the Examiner is encouraged to contact the undersigned attorney.

Respectfully submitted,

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